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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONTINUATION NO.
10/623,429	07/18/2003	David M. Koelle	G&C 30967.11-US-U1	3532

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EXAMINER

SALIMI, ALI REZA

ART UNIT PAPER NUMBER

1648

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,429

Applicant(s)

KOELLE ET AL.

Examiner

A R. Salimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-23 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) 13-32, 34 and 36-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 12, 33, 35 is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/18/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

This is a response to the amendment filed 7/13/2005. Claims 1-6, 24-27 have been canceled. Claims 7-9, and 35 have been amended. Claims 7-23 and 28-38 are pending in the application. Claims 13-32, 34, 36-38 have been withdrawn from consideration, as they are directed to distinct group(s). Claims 7-12, 33, 35 are under consideration.

Please note any ground of rejection that has not been repeated is removed.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In view of amendment to claim(s) that are under consideration, the previously cited art is removed. Thus, concerns raised previously are moot in their entirety. New Grounds of Rejection follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dilella et al (WO 95/06055).

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Dilella et al taught and claimed SEQ ID NO: 2, which is directed to UL26 product of herpes simplex virus (see Claims 1, 3, and page 29). This only differs since they did not specifically point to the region 475-483 of UL26 to induce immune response.

However, one of ordinary skill in the art at the time of filing would have been highly motivated by the teaching of Dilella et al to locate regions within the short polypeptide taught by Dilella et al to utilize the polypeptide in induction of immune response. The polypeptide disclosed by Dilella et al is only 638 amino acids long. Applicants are claiming a 200 amino acid long fragment. In effect Applicants have separated out the protein taught by Dilella et al into three pieces and claiming a big chunk as an unobvious invention. It is Office's position that Dilella et al taught a relatively short polypeptide expressed by UL26 region of HSV, and finding a short region to induce immune response in a suitable host would have been purview of one of ordinary skill in the art, absent any unexpected results. Especially given the fact that Applicants are claiming the large portions of the same polypeptide taught by Dilella et al. Moreover, the adjuvant and fusion protein is rather routine in this art. In addition, since the claim 9 is directed to any fusion protein having 475-483 of SEQ ID NO: 9 the fusion protein does read on large portion of polypeptide as disclosed by Dilella et al having the same 15mer. Thus, separating a known polypeptide into smaller pieces is within a purview of ordinary skill in the art, absent unexpected results. Thus, the invention as a whole is *prima facie* obvious absent unexpected results.

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Subject Matter Allowable over Prior art

Claims 7, 12, 33, 35 are deemed free of prior art, given failure of the prior art to teach or reasonably suggest the 15mer of SEQ ID NO: 9 to be used as an antigen to induce immune response. Locating the 15mer is seen as obvious to try but not necessarily obvious to succeed situation over the teaching of Dilella et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

8/3/2005


ALI R. SALIMI
PRIMARY EXAMINER